

REMARKS

These remarks are in response to the Office Action mailed March, 6, 2003. Claims 1-16 have been canceled without prejudice to Applicants' right to prosecute the canceled subject matter in any divisional, continuation, continuation-in-part, or other application. Claims 17-32 have been added. Support for the new claims can be found throughout the specification and claims as originally filed. No new matter is believed to have been introduced.

I. REJECTION UNDER 35 U.S.C. §112, FIRST PARAGRAPH

Claims 10-16 stand rejected under 35 U.S.C. §112, first paragraph, for allegedly containing subject matter not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 10-16 have been canceled, without prejudice, thus the rejection is moot with respect to these claims. Applicants respectfully traverse this rejection as applied to claims 17-32.

Claims 17-32 do not recite the term "preventing." Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection based upon 35 U.S.C. §112, first paragraph.

II. REJECTION UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Claims 1-16 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-16 have been canceled, without prejudice, thus the rejection is moot with respect to these claims. Applicants respectfully traverse with respect to claims 17-32.

Applicants believe that claims 17-32 overcome the rejection. For example, the claims recite the structure rather than just the reference numeral and properly sets forth antecedent basis for all the claim terms. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection based upon 35 U.S.C. §112, second paragraph.

III. REJECTION UNDER 35 U.S.C. §102(b)

Claims 1, 3, and 4 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Koelsch (Chem. Abstract 55:48596), Starnes (Chem. Abstract 69:43555), Morgan (U.S. Patent No. 3,546,165), Barili et al. (Chem. Abstract 107:58774), Manning et al. (Chem. Abstract 94:102538), Enokida et al. (Chem Abstract 126:39836; JP 08259936, Pub. Date 10/8/1996), and Rosnati et al. (Chem. Abstract 110:153506). Claims 1, 3, and 4 have been canceled, without prejudice, thus the rejection is moot with respect to these claims. Applicants respectfully traverse with respect to claims 17-32.

Koelsch does not anticipate the claims for at least the following reasons. With respect to RNs 102705-84-0 and 102242-25-1, the pending claims recite that “when - - - is single bond, R1 and R2 when taken together are =O, Y is absent, R3 and R4 are H, m = 0, n = 1; then (a) if R5 is absent, then R6 is not Br (para), or OMe (para) or OH (para); (b) if R5 is OH (para) then R6 is not -NMe₂ at the para position”. With respect to RN 102663-96-7, the claims recite that “when - - - is single bond, both R1 and R2 are H, Y is absent, R3 and R4 both are H, m = 0; (a) then n is not 0; and (b) if n is 1, then both R5 and R6 are not -NH₂ at para positions; (c) if n is 1, then both R5 and R6 are not -OH at the para position”. Because Koelsch does not anticipate the instant claims, reconsideration and removal of this rejection is respectfully requested.

Starnes does not anticipate the claims for at least the following reasons. The claims recite the limitation that “when - - - is single bond, R1 and R2 taken together are =O, Y is absent, R3 is -C(O)OEt, R4 is H, m = 0, n = 1, R5 is absent, then R6 is not -OH at the para position”. Because Starnes does not anticipate the instant claims, reconsideration and removal of this rejection is respectfully requested.

Morgan does not anticipate the following claims for at least the following reasons. The claims recite the limitation that “when - - - is single bond, both R1 and R2 are H, Y is absent, R3 and R4 both are H, m = 0; (a) then n is not 0; and (b) if n is 1, then both R5 and R6 are not -NH₂ at para positions; (c) if n is 1, then both R5 and R6 are not -OH at the para position”. Because Morgan does not anticipate the instant claims, reconsideration and removal of this rejection is respectfully requested.

Barili et al. do not anticipate the claims for at least the following reasons. The claims recite the limitation that “when - - - is single bond, R1 and R2 taken together are =O, Y is absent, R3 is Me, R4 is H, m = 0, n = 1, then both R5 and R6 are not -OH at the para position”.

Because Barili et al. do not anticipate the instant claims, reconsideration and removal of this rejection is respectfully requested.

Manning et al. do not anticipate the claims for at least the following reasons. The claims recite the limitation:

With respect to RNs 18636-52-7, 52033-61-1, 52033-63-3, and 75948-87-7, the claims recite that "when - - - is double bond, Y, R2 and R3 are absent, R1 and R4 are H, $m = 0$; (a) then n is not 0; (b) if n is 1, R5 is absent, then R6 is not -OMe (para), or Br (para), or -CN (para)".

With respect to RN 75948-87-7, the claims recite that "when - - - is single bond, R1 is -OH, R2 is H, Y is absent, R3 and R4 are H, $m = 0$, $n = 1$, R5 is absent, then R6 is not -Br at the para position".

With respect to RN 75961-47-6, the claims recite that "when - - - is single bond, R1 and R2 when taken together are =O, Y is absent, R3 and R4 are H, $m = 0$, $n = 1$; then (a) if R5 is absent, then R6 is not Br (para), or OMe (para) or OH (para); (b) if R5 is OH (para) then R6 is not -NMe₂ at the para position".

Because Manning et al. do not anticipate the instant claims, reconsideration and removal of this rejection is respectfully requested.

Enokida et al. do not anticipate the claims for at least the following reasons. The claims recite the limitation that "when - - - is single bond, both R1 and R2 are H, Y is absent, R3 and R4 both are H, $m = 0$; (a) then n is not 0; and (b) if n is 1, then both R5 and R6 are not -NH₂ at para positions; (c) if n is 1, then both R5 and R6 are not -OH at the para position". Because Enokida et al. do not anticipate the instant claims, reconsideration and removal of the rejection is respectfully requested.

Rosnati et al. do not anticipate the instant claims for similar reasons as given above.

Claims 1 and 2 stand rejected as allegedly anticipated by Gagnon (Beilstein Reg. No. 4924895. Gagnon does not anticipate the instant claims for at least the following reasons. The claims recite the limitation that "when - - - is single bond, R1 and R2 taken together are =N-OH.HCl, Y is absent, R3 and R4 are H, $m = 0$, then n is not 0". Because Gagnon does not anticipate the instant claim, reconsideration and removal of this rejection is respectfully requested.

Claims 1, 3, 4, and 5 stand rejected as allegedly anticipated by Miller et al. (Chem., Abstract 74:75859) and Hendrickson et al. (Chem. Abstract 110:113878). Claim 1 has been canceled. Claims 17-32 are not anticipated by Miller et al. or Hendrickson et al. for reasons as set forth above.

IV. REJECTION UNDER OBVIOUSNESS TYPE DOUBLE PATENTING

Claims 6-16 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 09/880,728. Claims 6-16 have been canceled, without prejudice, thus the rejection is moot with respect to these claims. Applicants respectfully traverse.

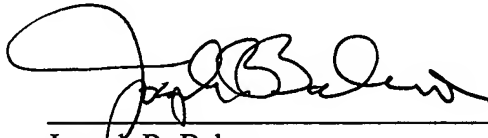
Applicants submit that claims 17-32 are non-obvious over the co-pending application. In addition, upon an indication of allowable subject matter Applicants will consider filing a terminal disclaimer over co pending Application Serial No. 09/880,728.

Applicant asks that all claims be allowed. Enclosed is a \$648 check for excess claim fees and for the Petition for Extension of Time fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: _____

7/7/03



Joseph R. Baker
Reg. No. 40,900

Fish & Richardson P.C.
4350 La Jolla Village Drive, Suite 500
San Diego, CA 92122
Telephone: (858) 678-5070
Facsimile: (858) 678-5099
10309869.doc